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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Kirsch et al.
Appl. No. : 09/924,396
Filed : August 6, 2001
For : IRON-REGULATING
PROTEIN-2 (IRP-2) AS A
DIAGNOSTIC FOR
NEURODEGENERATIVE
DISEASE

) Group Art Unit 1646
)

) I hereby certify that this correspondence and all
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) and Trademark Office, P.O. Box 2327,
) Arlington, VA 22202, on

) September 18, 2002

) (Date)

) Daniel E. Altman, Reg. No. 34,115

Examiner : Chernyshev, Olga.

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RESPONSE TO RESTRICTION REQUIREMENT

United States Patent and Trademark Office
P.O. Box 2327
Arlington, VA 22202

Dear Sir:

This paper is in response to the Office Action, mailed on July 18, 2002, setting a one-month term for response. Applicants respectfully request a One-Month Extension of Time, setting the new term to September 18, 2002. A check in the amount of \$110 is enclosed to cover the fee for the extension of time. Please charge any additional fees required, including any fees for additional extensions of time, or credit overpayment, to Deposit Account No. 11-1410.

INTERVIEW SUMMARY RECORD

Applicants appreciate the opportunity to discuss the restriction requirement set forth in the Office Action mailed on July 18, 2002, during a telephone interview on August 19, 2002, between Primary Examiner, John Ulm, and the undersigned attorney. In the course of the interview, claim 1, in particular the inventive nature of the peptide loop, corresponding to amino acid residues 132-216 of IRP-2, was discussed. Applicants' representatives explained that all of

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the species recited in the Markush groups of Claims 2, 3, 5, 6 and 14 include this inventive feature. Accordingly, the Primary Examiner agreed to treat the objection of claims 2, 3, 5, 6 and 14 as an election of species requirement such that if a generic claim is allowed, the Applicant would be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. Thus, it was agreed that the objection of Claims 2, 3, 5, 6 and 14 would be withdrawn upon allowance of a generic claim. Nevertheless, in view of the election set forth below, these claims will be pursued in a divisional application to be filed at a later date.

ELECTION IN RESPONSE TO RESTRICTION REQUIREMENT

Applicants were requested to elect, for examination purposes, the claims of one of Groups I-XXXIV, listed on pages 3-4 of the Office Action. Applicants hereby elect the claims of Group XVI (Claims 7-10, 18) drawn to a method of identifying a subject in need of treatment of a neurodegenerative disease involving a probe that interacts with *IRP protein*.

Groups XVI and XVII both comprise Claims 7-10 and 18. These claims recite a method of using a probe that interacts with either an IRP protein or a polynucleotide encoding an IRP protein. To the extent that the Examiner is requiring that Applicants narrow the claims to exclude the aspect of the invention relating to the non-elected invention, Applicants object on the same basis as described above in connection with the interview with Primary Examiner Ulm.

The elected claims recite a Markush group including the two recited classes of probes. This Markush group is proper because these two types of probes share a common inventive feature, namely, the IRP-2 protein. Specifically, the specification discloses at page 8, lines 1-8, that individuals suffering from a neurodegenerative disease have mutations in the IRP-2 gene that *result* in mutant IRP-2 proteins. Thus, the methods involving probes that interact with IRP protein and with polynucleotide encoding IRP protein both relate to assays that identify mutations in the IRP-2 protein, regardless of whether the method detects the protein itself or the nucleic acid that encodes for the protein. Accordingly, Applicants should not be required to amend the elected claims to exclude detection by use of a probe that interacts with polynucleotide encoding IRP protein.

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Applicants respectfully submit that the present application is in condition for examination on the merits. If any issues remain, the Examiner is invited to contact Applicants' counsel at the number listed below in order to resolve such issues promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Sept. 18, 2002

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